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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/823,527

04/13/2004

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EXAMINER

UBER, NATHAN C

ART UNIT

PAPER NUMBER

4143

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/823,527	<b>Applicant(s)</b> KENEAKI, TETSUHIKO	
	<b>Examiner</b> Nathan C. Uber	<b>Art Unit</b> 4143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>13 April 2007</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### **Status of Claims**

1. This action is in reply to the application filed on 13 April 2004.
2. Claims 1-16 are currently pending and have been examined.

### **Information Disclosure Statement**

3. The Information Disclosure Statement filed on 13 April 2004 has been considered. Foreign references submitted with the IDS that were not translated were not considered. An initialed copy of the Form 1449 is enclosed herewith.

### **Drawings**

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference characters not mentioned in the description: S15, S16 and S17 in Figure 3. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference characters in the description in compliance with 37 CFR 1.121(b) is required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### **Claim Rejections - 35 USC § 112**

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 3-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Various terms used throughout the claims are vague and indefinite and had inadequate support for their meaning in the specification. Additionally many of the terms are not the commonly used terms in the art.

The indefinite terms and Examiner's interpretation of those terms are listed below.

- Entered (see at least claim 3) – typed-in or printed-on
- Item (see at least claims 4 and 9 and their dependants) – any unit of data
- Receiving (see at least claims 4 and 9 and their dependants) – inputting
- Capturing (see at least claims 4 and 9 and their dependants) – storing
- Fed (see at least claims 4 and 9 and their dependants) – inputted
- Payment specifying unit (see at least claim 5) – a database that stores payment information
- Collate (see at least claim 9 and its dependants) – to gather or arrange

#### **Claim Rejections - 35 USC § 101**

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 15 and 16 are rejected under 35 U.S.C. 101 because the claims are directed to non-statutory subject matter. The *computer program product* of both claims is not a process, machine, manufacture, or composition of matter, or any improvement thereof. Replacing *computer program product* with “a computer-executable program tangibly embodied on a computer readable medium” is a suggestion for how to bring this claim into compliance with 35 U.S.C. 101 because “a computer-executable program tangibly embodied on a computer readable medium” is statutory subject matter.

### Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Walker et al. (US 6,138,106).

**Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

#### Claim 1:

Walker, as shown, discloses the following limitations:

- *a gift certificate comprising* (see at least column 5, lines 26-27),
- *a specific code for indicating at least a* (see at least column 5, lines 26-27 and 31-32),
- *paying method* (see at least column 4, lines 64-65),
- *instead of a face value* (see at least column 2, lines 32-33).

#### Claim 2:

Walker, as shown, discloses the following limitations:

- *the paying method is performed with* (see at least column 5, line 23),
- *a credit card possessed by* (see at least column 4, line 67),
- *a purchaser of the gift certificate* (see at least column 4, line 60).

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**Claim 3:**

Walker, as shown, discloses the following limitation:

- *a using condition is entered in the gift certificate* (see at least columns 10 and 11, lines 67 and 1-4 respectively, buyer may add limitations on the use of the gift certificate).

**Claim 4:**

Walker, as shown, discloses the following system limitations:

- *a first* (see at least column 4, lines 11-12, there are multiple displays),
- *display unit for* (see at least column 4, line 4, video display, monitor),
- *displaying a screen used for inputting an item* (see at least column 4, line 6, interface),
- *the item being required for use of a gift certificate* (see at least column 6, lines 54-56, any necessary data such as the value of the gift certificate),
- *input unit for receiving an input of the item based on the screen by the first display unit* (see at least column 4, lines 4-5, keyboard),
- *a holding unit for* (see at least column 4, line 36, database),
- *capturing the item fed into the first input unit* (see at least column 4, lines 36-38, storing the inputted data),
- *an issuing unit for issuing the gift certificate* (see at least column 6, line 65, generating a gift code/certificate and opening a corresponding record of the gift certificate, and see at least column 7, lines 56-58, transmitting the gift code/certificate electronically or in hardcopy),
- *a specific code for indicating at least a* (see at least column 5, lines 26-27 and 31-32),
- *paying method* (see at least column 4, lines 64-65, charge a credit card at time of issuance of the gift certificate or at the time of redemption of the gift certificate),
- *instead of a face value* (see at least column 2, lines 32-33, conceal the monetary value of the gift certificate from the recipient),

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- *based on the item captured into the holding unit* (see at least column 7, lines 30-32, payment method is stored and retrieved from the database).

**Claim 5:**

Walker, as shown, discloses the following system limitations:

- *a payment specifying unit* (see at least column 5, line 19, a database the stores and retrieves the payment method)
- *based on the item captured into the holding unit* (see at least column 7, lines 30-32, payment method is stored and retrieved from the database).

**Claim 6:**

Walker, as shown, discloses the following system limitations:

- *item includes at least one of a using condition in using the gift certificate* (see at least columns 10 and 11, lines 67 and 1-4 respectively, buyer may add limitations on the use of the gift certificate),
- *a password input in using the gift certificate* (see at least column 7, lines 3-5),
- *a paying method of the gift certificate* (see at least column 5, line 23).

**Claim 7:**

Walker, as shown, discloses the following system limitation:

- *the holding unit stores the specific code* (see at least column 5, line 19-21).

**Claim 8:**

Walker, as shown, discloses the following system limitation:

- *the issuing unit enters a using condition in the gift certificate* (see at least columns 10 and 11, lines 66, 67 and 1-10).

**Claim 9:**

Walker, as shown, discloses the following system limitations:

- *a second* (see at least column 4, lines 11-12, there are multiple displays),
- *display unit for* (see at least column 4, line 4, video display, monitor),

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- *displaying a screen used for inputting an item* (see at least column 4, line 6, interface),
- *the item being required for use of a gift certificate* (see at least column 6, lines 54-56, any necessary data such as the value of the gift certificate),
- *input unit for receiving an input of the item based on the screen by the first display unit* (see at least column 4, lines 4-5, keyboard),
- *a holding unit for* (see at least column 4, line 36, database),
- *capturing the item fed into the first input unit* (see at least column 4, lines 36-38, storing the inputted data),
- *a paying unit for* (see at least Figure 2, the certificate redemption program of the central controller),
- *executing a collation* (see at least column 4, lines 24-26, central controller gathers and arranges data based on input and stored data),
- *based on the item captured by the holding unit* (see at least column 7, lines 30-32, payment method is stored and retrieved from the database),
- *and then executing a predetermined processing based on a collation result* (see at least column 4, lines 34 and 35, connected to a credit card processing network).

**Claim 10:**

Walker, as shown, discloses the following system limitations:

- *the item includes at least one of a specific code entered in the gift certificate* (see at least column 5, lines 26-27 and 31-32),
- *information of a desired commodity* (see at least columns 10 and 11, lines 67 and 1-4 respectively, buyer may add limitations on the use of the gift certificate),
- *a password* (see at least column 7, lines 3-5).



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**Claim 11:**

Walker, as shown, discloses the following system limitation:

- *the item is displayed in a question form on the second display unit (see at least column 7, lines 3-5).*

**Claim 12:**

Walker, as shown, discloses the following system limitations:

- *the processing executed by the paying unit includes at least one of a predetermined paying processing (see at least column 4, lines 34 and 35, connected to a credit card processing network),*
- *an invalidating processing of the gift certificate (see at least column 7, lines 45-46).*

**Claim 13:**

Walker, as shown, discloses the following method limitations:

- *displaying a screen used for inputting an item (see at least column 4, line 6, interface),*
- *the item being required for use of a gift certificate (see at least column 6, lines 54-56, any necessary data such as the value of the gift certificate),*
- *receiving an input of the item based on the screen (see at least column 4, lines 4-5, keyboard),*
- *capturing the input item (see at least column 4, lines 36-38, storing the inputted data),*
- *issuing the gift certificate (see at least column 6, line 65, generating a gift code/certificate and opening a corresponding record of the gift certificate, and see at least column 7, lines 56-58, transmitting the gift code/certificate electronically or in hardcopy),*
- *a specific code for indicating at least a (see at least column 5, lines 26-27 and 31-32),*
- *paying method (see at least column 4, lines 64-65, charge a credit card at time of issuance of the gift certificate or at the time of redemption of the gift certificate),*

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- *instead of a face value* (see at least column 2, lines 32-33, conceal the monetary value of the gift certificate from the recipient).

**Claim 14:**

Walker, as shown, discloses the following method limitations:

- *displaying a screen used for inputting an item* (see at least column 4, line 6, interface),
- *the item being required for use of a gift certificate* (see at least column 6, lines 54-56, any necessary data such as the value of the gift certificate),
- *receiving an input of the item based on the screen* (see at least column 4, lines 4-5, keyboard),
- *capturing the input item* (see at least column 4, lines 36-38, storing the inputted data),
- *executing a collation* (see at least column 4, lines 24-26, central controller gathers and arranges data based on inputted and stored data),
- *based on the captured item* (see at least column 7, lines 30-32, payment method is stored and retrieved from the database),
- *and then executing a predetermined processing based on a collation result* (see at least column 4, lines 34 and 35, connected to a credit card processing network).

**Claim 15:**

Walker, as shown, discloses the following limitations:

- *computer program product for issuing a gift certificate* (see at least column 4, line 40)
- *displaying a screen used for inputting an item* (see at least column 4, line 6, interface),
- *the item being required for use of a gift certificate* (see at least column 6, lines 54-56, any necessary data such as the value of the gift certificate),
- *receiving an input of the item based on the screen* (see at least column 4, lines 4-5, keyboard),
- *capturing the input item* (see at least column 4, lines 36-38, storing the inputted data),

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- *issuing the gift certificate* (see at least column 6, line 65, generating a gift code/certificate and opening a corresponding record of the gift certificate, and see at least column 7, lines 56-58, transmitting the gift code/certificate electronically or in hardcopy),
- *a specific code for indicating at least a* (see at least column 5, lines 26-27 and 31-32),
- *paying method* (see at least column 4, lines 64-65, charge a credit card at time of issuance of the gift certificate or at the time of redemption of the gift certificate),
- *instead of a face value* (see at least column 2, lines 32-33, conceal the monetary value of the gift certificate from the recipient).

**Claim 16:**

Walker, as shown, discloses the following limitations:

- *computer program product for using a gift certificate* (see at least column 4, line 40)
- *displaying a screen used for inputting an item* (see at least column 4, line 6, interface),
- *the item being required for use of a gift certificate* (see at least column 6, lines 54-56, any necessary data such as the value of the gift certificate),
- *receiving an input of the item based on the screen* (see at least column 4, lines 4-5, keyboard),
- *capturing the input item* (see at least column 4, lines 36-38, storing the inputted data),
- *executing a collation* (see at least column 4, lines 24-26, central controller gathers and arranges data based on inputted and stored data),
- *based on the captured item* (see at least column 7, lines 30-32, payment method is stored and retrieved from the database),
- *and then executing a predetermined processing based on a collation result* (see at least column 4, lines 34 and 35, connected to a credit card processing network).

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### **Conclusion**

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Albrect (US 5,984,180) discloses a gift certificate in the form of and employing a credit instrument.
- Sachs (US 6,240,397) discloses electronic gift certificates with various features including using conditions and concealed face values.

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12. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Nathan C Uber** whose telephone number is **571.270.3923**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James A Reagan** can be reached at **571.270.6710**.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

14. Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**Washington, D.C. 20231**

or faxed to **571-273-8300**.

15. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

Randolph Building

401 Dulany Street

Alexandria, VA 22314.

/Nathan C Uber/ Examiner, Art Unit 4143

5 December 2007

/James A. Reagan/Supervisory Patent Examiner, Art Unit 4143